

REMARKS

The Applicants note that in the *Decision on Appeal* the BPAI did not consider the Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131) filed July 3, 2000 and further note that the *Decision on Request for Rehearing* also refused to consider the updated Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131), filed November 24, 2003, containing the signature of each inventor.

The *Decision on Appeal* refused to consider the original Declaration, under § 1.131, due to the failure to comply with several formal requirements for submission of a proper declaration under Rule § 1.131. Specifically, the *Decision on Appeal* noted that the original Declaration, under § 1.131, was signed only by David Kessler rather than each of the inventors David Kessler, Allan Nutt and Russell Palum, as is required by MPEP Chapter 715.04. This failure to have the each inventor sign the Declaration of July 3, 2000 was an error without deceptive intent by the Applicants in understanding the requirement of 37 C.F.R. § 1.131(a):

"the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based."

to mistakenly mean that an inventor of the claimed subject matter may prepare an oath or declaration.

In order to remedy this deficiency noted by the *Decision on Appeal*, the Applicants submitted a Request for Rehearing, on November 24, 2003, which included a corrected Declaration, under § 1.131, properly executed by each of the inventors and further included a first missing piece of evidence, i.e., a "photocopy of David Kessler's personal log marking August 3, 1995 as the day of invention"

referenced in the original Declaration under § 1.131. However, the BPAI refused to consider the properly executed Declaration, and obviously misplaced evidence by the USPTO, in its *Decision on Request for Rehearing* under the position that such a submission does not meet the criteria of 37 C.F.R. 1.197(b) that the BPAI must conduct the rehearing based upon the same record as the original decision.

Consequently, the instant Request for Continued Examination and Response have been filed, and the Examiner is respectfully requested to further consider the updated and properly executed "Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131)" filed with the Request of November 24, 2003, as well as the arguments presented in traversal of findings set forth in the Examiner's Answer.

Initially, it is noted that the updated Declaration, under § 1.131, includes another copy of the David Kessler's personal log of marking August 3, 1995 as the day of invention referenced in the original Declaration, under § 1.131, which apparently had been lost or misplaced after consideration of the original Declaration by the Examiner in preparation of the *Examiner's Answer* of February 28, 2001.

Turning to the Examiner's statements, in the Examiner's Answer, regarding the showings of the original Declaration, under § 1.131, "as being insufficient to establish conception of the invention prior to the effective filing date" of the Fukushima (U.S. Patent 5,579,420) and the Fukushima et al. (U.S. Patent 5,646,399) references, i.e. prior to February 7, 1996 and January 29, 1996, respectively, the Applicants again assert that the new Declaration, under § 1.131, clearly establishes that the Applicants had possession of the invention as set forth in the instant claim 1 prior to January 29, 1996. Specifically, claim 1 sets forth the following features:

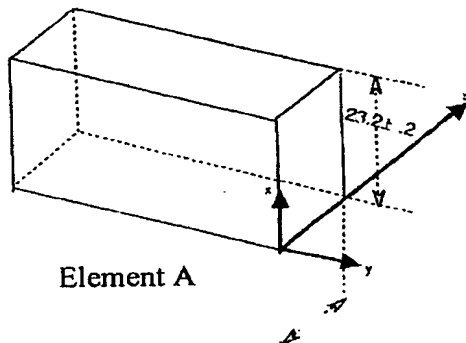
An imaging apparatus for generating an image signal from incident light...comprising:

an image sensor for generating the image signal from an array of photosites;

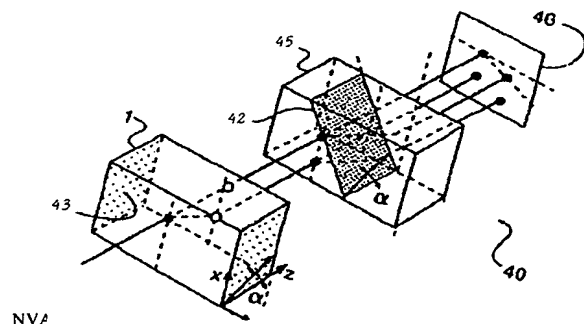
an optical section having a birefringent uniaxial crystal spatial

filter...said birefringent uniaxial crystal spatial filter birefringence being greater than 0.05, and ...being lithium niobate; and
wherein said spatial filter of a first plane plate and at least a second plane plate of lithium niobate. (Emphasis Added)

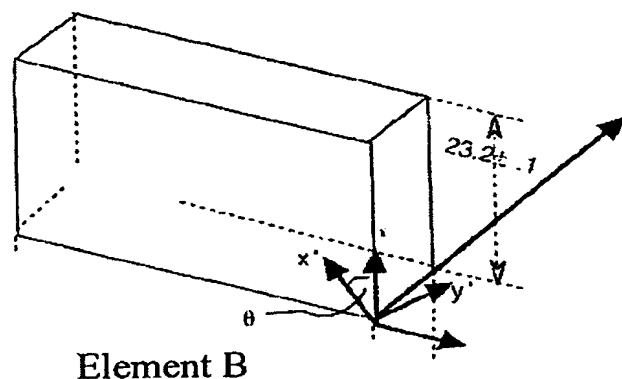
A review of the David Kessler's personal log page of August 3, 1995, clearly indicates that the invention is the use of lithium niobate crystals as blur filters (in a camera). As noted in the instant specification, at pages 1 and 2, it is well known to use a birefringent blur filter between the lens and image sensor array in cameras to overcome the aliasing or artifact problems occurring when capturing the image of an object having fine details. Shortly, after recording the invention in the personal log page of August 3, 1995, Mr. Kessler contacted Mr. Mizell at Virgo Optics and subsequently prepared Purchase Requisition No. 88240, on August 31, 1995, which ordered two sets (Items A and B) of lithium niobate prisms from Virgo Optics utilizing drawings attached thereto. A prism from the first set (Item A) of lithium niobate prisms is shown below:



which is the same structure as the prism 43 illustrated in Figure 4 (below) of the present invention and which is referred to in the personal log page of August 3, 1995:



Additionally, a prism from the second set (Item B) of lithium niobate prisms is shown below:



which is the same structure as the prism 42 illustrated in Figure 4 (above) of the present invention and which is also referred to in the personal log page of Mr. Kessler. Further, note that the corrected Declaration, under § 1.131, establishes, via the Virgo Optics Shipping Packlist of September 11, 1995, that the eight prisms ordered with Purchase Requisition No. 88240 were shipped Airborne Express on September 29, 1995 to the inventors at Eastman Kodak. From the above facts which are set forth in the corrected Declaration, under § 1.131, and supporting documentary evidence, it is clear that the Applicants conceived of the invention set forth in claim 1 (lithium niobate blur filters) before the filing date of the Fukushima references.

The Examiner's statement in the Examiner's Answer that, with regard to the evidence documents submitted with the original Declaration, under § 1.131, "only the predated documents are relevant for argument" is not understood since the MPEP Chapter 715.07 clearly states that there are three ways to show prior invention via filing of a Rule § 1.131 declaration:

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member

country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909). (Emphasis Added)

Therefore, the Examiner's failure to consider the documentary evidence submitted having dates which do not pre-date the filing date of the Fukushima ('420) reference is completely inappropriate and counter to the specific instructions and guidance provided in the MPEP Chapter 715.07. That is, each evidentiary documents attached to the corrected Declaration, under § 1.131, having a date after the filing date of Fukushima ('420) or Fukushima et al. ('399) are for the purposes of establishing reasonable diligence up to the actual reduction to practice, which is evidenced by the Kodak Invention Disclosure of August 27, 1996.

The Applicants again assert that upon consideration of the newly signed

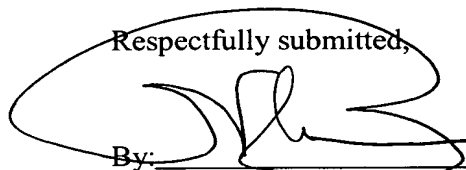
“Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131)” along with the documentary evidence submitted previously, it is clear that the inventors conceived of the present invention of claim 1 prior to the January 29, 1996 filing date of the Fukushima et al. patent (as well as the Fukushima ('420) patent) and further that the inventors have shown reasonable diligence in reducing the invention to practice after the filing date of the Fukushima et al ('399) reference. Consequently, since the Fukushima patents are no longer prior art to the instant claims, the rejections of claims 1, 4, 5, 10-12, 15, 17 and 18, under 35 U.S.C. 103(a), based upon the teachings of Greivenkamp, Jr. (U.S. Patent 4, 575,193) and either the Fukushima ('420) or Fukushima et al patents are no longer proper since each feature of the claimed invention is not taught or suggested by the Greivenkamp, Jr. reference alone.

Finally, if the Examiner is to maintain the position that the corrected Declaration, under § 1.131, is “insufficient to establish conception of the invention prior to the effective filing date” of the Fukushima (U.S. Patent 5,579,420) and the Fukushima et al. (U.S. Patent 5,646,399) references, i.e. prior to February 7, 1996 and January 29, 1996, then the Applicants specifically request the Examiner to provide:

- 1) a basis in law for maintaining such a position, and further include,
- 2) a reference to and specific discussion of the deficiency of each piece of evidence presented in the corrected Declaration, under § 1.131, in failing to establish conception and diligence up to the relevant date, i.e., January 29, 1996 of the Fukushima et al. (U.S. Patent 5,646,399).

Having responded to the rejections set forth in the Examiner's Answer and to the deficiencies noted in the BPAI *Decision on Appeal*, it is submitted that claims 1, 4, 5, 10-12, 15, 17 and 18 are in condition for allowance. An early and favorable Notice of Allowance is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of

the above claims or if some portion of the instant submission is again lost or misplaced by the USPTO, the Examiner is courteously requested to contact Applicants' undersigned representative.

Respectfully submitted,

By: _____
Nelson A. Blish
Registration No. 29,134

EASTMAN KODAK COMPANY
Patent Legal Staff
343 State Street
Rochester, New York 14650-2201

Telephone: (585) 588-2720
Facsimile: (585) 477-4646

NAB/JWM